

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 020366-074900US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on <u>June 21, 2007</u> . TOWNSEND and TOWNSEND and CREW LLP By: <u>/Janet L. Newmaker/</u> Janet L. Newmaker		Application Number 09/785,864	Filed February 16, 2001
		First Named Inventor Gregory Bruening	
		Art Unit 2614	Examiner Karen L. Le
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,358</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		<u>/Irvin E. Branch/</u> _____ Signature <u>Irvin E. Branch</u> _____ Typed or printed name <u>303-571-4000</u> _____ Telephone number <u>June 21, 2007</u> _____ Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

<input checked="" type="checkbox"/> *Total of <u>1</u> form is submitted.

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PATENT
Attorney Docket No.: 020366-074900US

TOWNSEND and TOWNSEND and CREW LLP

By: /Janet L. Newmaker/
 Janet L. Newmaker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gregory Bruening et al.

Application No.: 09/785,864

Filed: February 16, 2001

For: Implementing Feature
Interactions Between An AIN-
Based Service And A Switch-
Based Forwarding Service

Customer No.: 20350

Confirmation No.: 6331

Examiner: Karen L. Le

Art Unit: 2614

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants request review of the final rejection for the above-identified application. A response after final was filed on March 15, 2007. No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

Final Office Action Improperly Made Final

As an initial matter, the Applicants respectfully point out that the final Office Action was improperly made final. A second or subsequent action is improper when “the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendments of the claims nor based on information submitted in an information disclosure statement . . .” (see MPEP § 706.07(a) and 37 C.F.R. § 1.113). Neither is the case here. The Applicants’ prior response contained no claim amendments, and the Applicants have not filed an Information Disclosure Statement since the previous Office Action. But the claims now stand rejected under 35 U.S.C. § 103(a), whereas the claims were previously rejected under 35 U.S.C. § 102(b). Hence, this new ground of rejection was not necessitated by the Applicants’ amendment or late-submitted prior art. The Applicants, therefore, respectfully request reconsideration of the finding that the pending Office Action should be final.

Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully request review of the rejections of all pending claims under 35 U.S.C. § 103(a) since the Office Action has not established a prima facie case of obviousness with respect to any pending claim. Specifically, the Office Action does not cite a reference in the prior art that teaches or suggests each and every claim element and the Office Action does not cite a motivation that existed in the prior art to modify the reference to make the Applicants’ claimed invention. Hence, the Applicants respectfully request that the matter be immediately moved to allowance.

Both the final Office Action and the Advisory Action concede that Cheng fails to teach or suggest a number of claim elements (see Advisory Action, p. 2, and Final Office Action, pp. 2-7). The final Office Action and Advisory Action, however, state that such limitations were old and well known in the art. Although the final Office Action provided no citation to such teaching, the Advisory Action included a citation to U.S. Patent No. 5,517,562. It appears that the Examiner is attempting yet again to introduce a new ground of rejection, this time in an

Advisory Action (as stated above, the final Office Action was improperly made final because a new ground of rejection was introduced which the Applicants did not necessitate). Note, however, that even though it is procedurally improper for the Examiner to introduce a new reference at this stage of prosecution, the Applicants' cursory review of the newly-cited reference reveals that even this reference appears not to teach or suggest all of the claimed elements that are missing from Cheng.

Moreover, neither the final Office Action nor the Advisory Action cited a teaching or suggestion that one skilled in the art would be motivated to modify the teachings of Cheng and/or combine them with the prior art to make the Applicants' claimed invention. The Office Action appears to suggest that one would have been so motivated "in order to give the instruction to SSP to reject the call or to forward the call to a forward-to number." This reasoning appears to assign a missing function to a claim element and call it a motivation. Hence, there being no cited motivation, the Applicants respectfully request that the matter be immediately advanced to allowance.

If the case is not moved to allowance in light of the shortcomings noted herein, the Applicants respectfully point out that a new, non-final Office Action is in order.

Conclusion

In view of the foregoing, the Applicants respectfully request withdrawal of the rejections and issuance of a formal Notice of Allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: June 21, 2007

/Irvin E. Branch/

Irvin E. Branch

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